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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/859,518	05/18/2001	Alessandro Seneci	622-46	4287
23117	7590	11/18/2003	EXAMINER	
NIXON & VANDERHYE, PC 1100 N GLEBE ROAD 8TH FLOOR ARLINGTON, VA 22201-4714			HENDRICKS, KEITH D	
			ART UNIT	PAPER NUMBER
			1761	

DATE MAILED: 11/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/859,518

Applicant(s)

SENECI, ALESSANDRO

Examiner

Keith Hendricks

Art Unit

1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9-12 & 10-16-2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6,9,27 and 28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6,9,27 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 20030909.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Currently, claims 1-2, 4-6, 9 and 27-28 are pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1, and thus claims 2, 4-6, 9 and 27-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Page 2 of the specification states that:

The scope of the present invention is therefore an edulcorating soluble composition containing at least an alimentary non gelating soluble fibre, if necessary in mixture with other alimentary fibers chosen among the gelating alimentary fibres soluble, insoluble or partially soluble, and one or more sweeteners if necessary in mixture among themselves.

Applicants' specification, however, does not provide support for the instantly-claimed invention. A powder "consisting essentially of from 50 to 98% by weight of inulin and from 0.2 to 50% by weight of at least one synthetic sweetener" is not supported by the specification, as specifically recited in current claim 1. Initially, it is noted that if the maximum amount of inulin (98%) and the minimum amount of synthetic sweetener (0.2%) were utilized, this would inherently leave 1.8% of the composition as an unnamed component. Applicants' specification does not provide support for a composition "consisting essentially of" only the components of inulin and a synthetic sweetener. Applicant has not provided support or guidance as to what components may be included such that they would not "materially affect the invention", as required by case law with regard to "consisting essentially of" patent language. Applicants' examples include flavors and other compounds which would be expected to "materially affect the invention". The specification provides general language potentially supporting a composition "consisting of" inulin and a synthetic sweetener, and the specification provides support for compositions "comprising" these two components. However, as the specification does not provide guidance as to the

production of a composition "consisting essentially of" these two components, and potentially some unnamed and unknown amount of other components, the claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 and thus claims 2, 4-6, 9 and 27-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are indefinite for the recitation of a powder "consisting essentially of from 50 to 98% by weight of inulin and from 0.2 to 50% by weight of at least one synthetic sweetener". If the maximum amount of inulin (98%) and the minimum amount of synthetic sweetener (0.2%) were utilized, this would inherently leave 1.8% of the composition as an unnamed component. The phrase "consisting essentially of" is more narrow patent language than "comprising", and only broader than "consisting of" in the sense that it provides for the recited components as the only components in the composition, save for (minor) potential amounts of additional components which would "not materially affect the invention". In other words, applicants' use of the recited percentages, conflicts with the phrase "consisting essentially of". The previous use of "containing" (interpreted as "comprising" language) left room for the unnamed 1.8% of one or more other components. The specification provides general language supporting a composition "consisting of" inulin and a synthetic sweetener, and the specification provides support for compositions "comprising" these two components with other materials. However, as the specification does not provide guidance as to the production of a composition "consisting essentially of" these two components, and potentially some unnamed and unknown amount of other components, the metes and bounds of the claimed invention are unclear.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 9 and 27-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Yotka et al. The reference and rejection are taken as cited in a previous Office action.

Applicant's arguments filed September 12, 2003 have been fully considered but they are not persuasive. At page 6 of the response, applicants state that the reference does not anticipate the claims because "the working examples of Yotka disclose chewing gum compositions containing aspartame in combination with sugar and/or other natural bulk sweeteners", but that "no disclosed chewing gum formulation contains inulin together with a synthetic sweetener as the only sweetening agent."

This is not deemed persuasive for the reasons of record. Initially, it is noted that, just as applicants' own specification, the teachings of the reference are by no means limited solely to the examples. Thus, to focus on these limited teachings alone would be an improper review of the reference. Secondly, it is noted that applicants' claims are not drafted as closed-language "consisting of" type claims, and thus applicants' comment with regard to the reference that "no disclosed chewing gum formulation contains inulin together with a synthetic sweetener as the only sweetening agent," is not well taken. As stated above, applicants' specification does not provide a teaching as to what types of compounds may or may not be included or excluded from the claimed composition, including minor amounts of additional sweeteners, whether artificial or natural.

At page 6 of the response, applicants state that "Yotka discloses the 'initial co-drying' of the oligofructose with bulk-sweeteners only (see col. 6, lines 11 to 33 and 54 to 66)." This is not deemed persuasive for the reasons of record, and again, is not a fair or accurate reading of the reference. It is interesting that applicants' cited passages overlook the paragraph at column 6, lines 44-53, where it is specifically stated that

Oligofructose may be able to encapsulate, agglomerate or entrap/absorb flavors and high-intensity sweeteners like aspartame, alitame, cyclamic acid and its salts, saccharin acid and its salts, acesulfame and its salts, sucralose, dihydrochalcones, thaumatin, monellin or combinations thereof. Encapsulation of high-intensity sweeteners with oligofructose may improve the sweetener's shelf life.

See also column 3, lines 8-14, and the line connecting columns 6-7. Furthermore, it is important to note that oligofructose, i.e. inulin, in fact *is* a bulk sweetener, as stated at several passages within the reference. For example, see the first sentence of column 2, as well as column 2, lines 23-26. In fact, within the passages that applicant has cited, column 6, line 11 refers to "oligofructose bulk sweeteners".

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Applicants' following comment is not understood and does not appear to be supported by the teachings of the reference, and those cited above. Applicant states that

when Yotka refers to high intensity sweeteners, this is only in the context that the oligofructose "may be able to encapsulate, agglomerate or entrap/absorb flavors and high intensity sweeteners, including aspartame, alitame, cyclamic acid and its salts, saccharine and its salts. ..." (column 6, line, 44 onwards). In other words, Yotka does not disclose a powder formulation consisting essentially of inulin together with only synthetic sweeteners.

This is not deemed persuasive, as the very idea of encapsulating the high intensity (synthetic) sweeteners, is to produce a powdered form of this composition. Column 4, lines 54-55 of the reference state that "*in its powder or liquid form, a sufficient quantity of oligofructose can stabilize aspartame*" (emphasis added). Column 18, line 66 to column 19, line 2 of Yotka et al., state that "oligofructose may also be *codried* with high intensity, artificial sweeteners by *spray drying*, fluid bed coating, spray congealing or agglomeration, and used in the formulations in Tables 11 and 12 at active levels of the various high intensity sweeteners noted above." Simply put, these methods yield powders "consisting essentially of" inulin and artificial sweetener.

Conclusion


Claims 4-6 remain free of the prior art of record, and are objected to as being dependent upon a rejected claim.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith Hendricks whose telephone number is (703) 308-2959. The examiner can normally be reached on M-F (8:30am-6pm); First Friday off.

** Beginning December 10, 2003, the examiner's new telephone number will be (571) 272-1401.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (703) 308-3959. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9565 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


KEITH HENDRICKS
PRIMARY EXAMINER